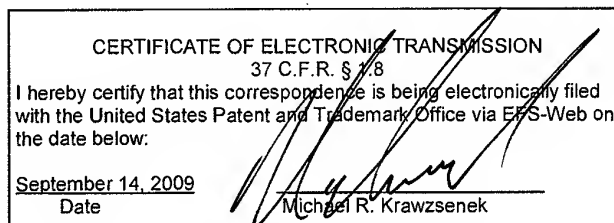


PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: CASING SYSTEM
Appl. No.: 10/675,548
Appellant: Stavenjord, Walter Karl
Filed: September 30, 2003
TC/A.U.: 3633
Examiner: A, Phi Dieu Tran
Docket No.: FMDM:002US
Customer No.: 32425
Confirmation No. 5963



REPLY BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Commissioner:

Appellant submits this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer mailed August 28, 2009 ("Examiner's Answer"). A Request for Oral Hearing is not being filed. It is believed that no fee is due in connection with the filing of this Reply Brief. However, should any fees under 37 C.F.R. § 41.20 be required for any reason relating to the enclosed document, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski L.L.P. Account No.: 50-1212/FMDM:002US.

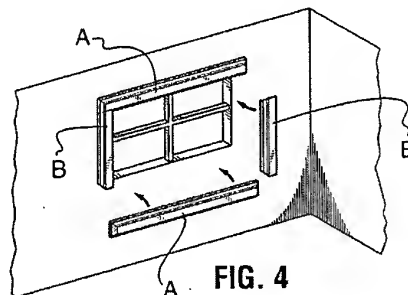
I. APPELLANT'S REPLY TO THE ARGUMENTS MADE IN THE EXAMINER'S ANSWER

The anticipation and obviousness rejections are maintained in the Examiner's Answer. Appellant disagrees with these rejections and incorporates by reference the arguments set forth in the Appeal Brief. Appellant submits the following additional comments in reply to the Examiner's Answer.

A. Appellant's Claimed "Casing System" Is Not Anticipated By Pugh

Appellant's claimed invention is directed to a "casing system" and a "kit of parts for forming a casing system." Independent claims 1, 12, and 15 explain that that the casing system "cover(s) gaps between framing members of structural openings and vertical walls in buildings."

FIG. 4 of Appellant's specification provides a non-limiting embodiment of this casing system:



The Examiner's analysis of Pugh is faulty in several respects. The following bullet points illustrate the Examiner's arguments and why these arguments are flatly incorrect:

- *The Examiner ignores the teachings of Pugh by arguing that this reference "shows a casing system" (page 3 of Answer)*
-There can be no dispute that Pugh concerns "tiles for floors." Pugh at col. 1, lines 8-11. There is simply no disclosure (or even a suggestion) in Pugh of using these floor tiles in a casing system to cover gaps between framing members of structural opens and vertical walls in buildings as claimed by Applicant. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.").

- *The Examiner improperly reasons that the “adapted to” language in claims 1, 12, and 15 “was considered and given little patentable weight as it is clearly an intended use situation” (page 6 of Answer)*

-The “adapted to” language is the heart of the claimed casing system. This language provides structural limitations to the claims that are simply not disclosed in Pugh. For instance, the claimed first and second casing pieces are relatively light in weight in that they can be mounted on a vertical wall and connected to one another in a unique manner—*i.e.*, they are adapted to be used in a casing system. Additionally, the claimed structural features of the casing pieces allow these pieces to interconnect with one another and overlap the gaps between a vertical structural wall and an amenity such as a door or a window installed within a rough opening provided in the wall. Further, the structural features of these pieces reduce the number of pieces needed to cover such gaps (*e.g.*, no more than four pieces could be used to cover gaps between a window frame and a wall). *See, e.g.*, specification at FIG. 4. Also, specialized equipment is not needed to install these casing pieces in view of the structural features that allow the first and second casing pieces to interconnect with one another. *See, e.g., id.* at page 6, lines 4-9; page 9, lines 18-28. Therefore, and contrary to the Examiner's conclusions, Appellant's “adapted to” language is relevant to the patentability of these claims in that it provides structural features that allow the casing pieces to be used in a casing system.

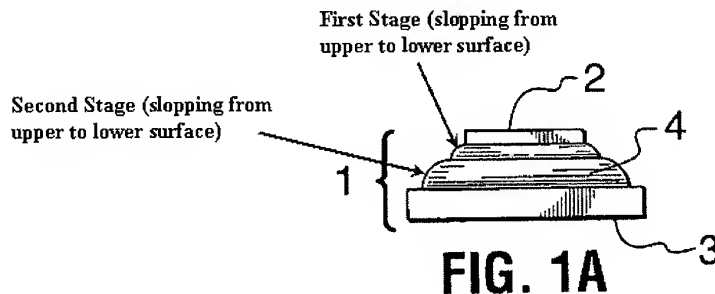
-By comparison, the Pugh floor tiles are relatively thin with large flat-surface dimensions that are not suitable or amenable for use as casings on vertical walls. Second, the installation of the Pugh floor tiles to cover gaps between window or door frames and vertical structural walls would require many tiles to cover the gaps between each side of the framework and the vertical wall, and thus, would require considerable skill and time for installation. Finally, Pugh does not disclose how to modify the floor tile to make it useful as a single decorative casing piece to cover a gap between vertical wall and an amenity framework.

- *The Examiner's statement that “[t]he claim as set forth does not prevent applicant from using the casing system in another environment per se” (page 6 of Answer) is misplaced*

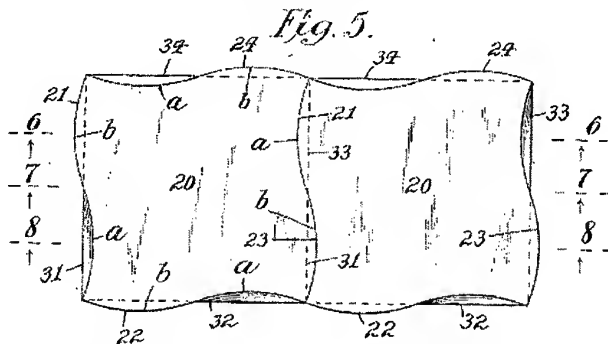
-It appears that the Examiner is reasoning that because “[t]he claim as set forth does not prevent applicant from using the casing system in another environment per se,” the Appellant's “adapted to” language is an intended use limitation. This analysis is misplaced and contrary to the facts of this. It is misplaced in view of the fact that an anticipation analysis must be focused on whether Pugh discloses every element of the claimed invention and not whether Applicants claimed invention can be used in “another environment.” *See In re Bond*, 910 F.2d at 832. It is contrary to the facts of this case in that the “adapted to” limitation provides structural features (see above).

- The Examiner incorrectly concludes that Pugh discloses the elements in dependent claim 7 by arguing that "the decorative profile comprising a sloping surface extending from the upper face to the lower face in at least two stages (per the curve of a and b)" (page 3 of Answer)

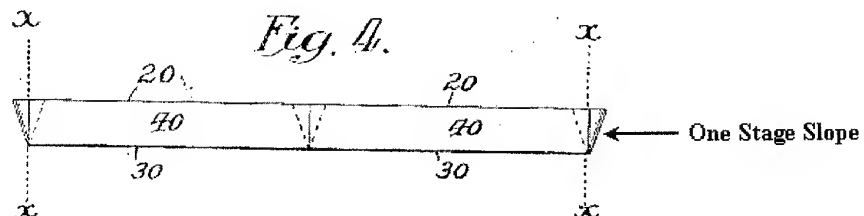
-Dependent claim 7 recites, in part, "wherein said decorative profile provided on said linear edges of said first casing piece comprises a sloping surface **extending from said upper face to said lower face in at least two stages**" (emphasis added). This is illustrated in a non-limiting way in at least FIG. 1A of Appellant's specification (arrow and text added by Appellant):



-Contrary to the Examiner's conclusion, FIG. 5 has one continuous slope—i.e., there is not two stages that extend from the upper face to the lower face:



This is more clearly illustrated in the cross-sectional view of FIG. 5, which is FIG. 4 of Pugh:



For at least these reasons, Appellant requests that the Board overturn the rejection of claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by Pugh.

B. Appellant's Claimed "Casing System" Is Not Anticipated By Gascho

The Examiner's analysis of Gascho is faulty in several respects. The following bullet points illustrate the Examiner's arguments and why these arguments are flatly incorrect:

- *The Examiner ignores the teachings of Gascho by arguing that this reference "shows a casing system" (page 4 of Answer)*
-There can be no dispute that Gascho discloses stackable logs that are used for building a wall for a log cabin or for building a retaining wall. Gascho at col. 1, lines 6-32 and FIGS. 7-8. There is simply no disclosure (or even a suggestion) in Gascho of using these stackable logs to cover gaps between framing members of structural openings and vertical walls in buildings as claimed by Applicant. See *In re Bond*, 910 F.2d and 832.
- *The Examiner incorrectly argues that "nothing in [Gascho] would prevent the reference from being able to function as claimed" (page 6 of Answer)*
-Several things about the Gascho stackable logs would prevent such logs from being used as Appellant's casing system. For instance, a person of ordinary skill in the art would easily recognize that the Gascho logs are of considerable heft, as they are used to build log cabin walls and retaining walls. In fact, Gascho confirms this by explaining that the logs are used to build a "solid wall." Gascho at col. 5, lines 63-65. The heft of the Gascho logs would likely be too much for use as casings. The same can also be said about the thickness of these logs making them unsuitable for use as casings.

For at least these reasons, Appellant requests that the Board overturn the rejection of claims 1-5, 7-8, and 10 under 35 U.S.C. § 102(b) as being anticipated by Gascho.

C. Pugh Fails to Render Dependent Claim 16 Obvious

The Examiner's analysis of Pugh in the context of the obviousness rejection of dependent claim 16 is faulty in several respects. The following bullet points illustrate the Examiner's arguments and why these arguments are flatly incorrect:

- *The Examiner's statement that "since the instructions (printed matter) are not functionally related to the structure of the kit, the claimed invention does not patentably distinguish from the prior art reference" (page 7 of Answer) ignores the limitations in claim 15 and the teachings of Appellant's specification*
-Claim 16 depends from claim 15. Claim 15 concerns a kit of parts for forming a casing system. The kit includes first and second casing pieces. These casing pieces are adapted to be joined together (see claim 15). It is clear that the

instructions are functionally related to the first and second pieces connecting to one another. It is not necessary under U.S. Patent law for claim 16 to specifically describe such instructions.

-There is simply no dispute that Pugh fails to disclose a casing system—much less instructions for installing the same. Further, there is no “apparent reason” to modify Pugh “in the fashion claimed by” Appellant. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. slip op. at 14-15 (2007) (discussing obviousness and a motivation to combine references). Because of this, a *prima facie* case of obviousness has not been established. MPEP 2143 (“To establish a *prima facie* case of obviousness...the prior art reference (or references when combined) must teach or suggest all the claim limitations.”).

- *The Examiner’s argument that Pugh is analogous art (page 7 of Answer) is wrong*

-It is important to note that the Examiner does not appear to take a position on whether Pugh is in Appellant’s field of endeavor (casing systems) or reasonably pertinent to the problem with which Appellant was concerned with (to cover gaps between framing members of structural openings and vertical walls in buildings for walls). The fact remains that neither is true of Pugh:

-Pugh undisputedly concerns floor tiles—not casing systems.

-Further, the problem with which Pugh was concerned with was floor tiles separating from one another due to their attachment with one another (hence, the interlocking Pugh floor tiles). Pugh at col. 1, lines 12-25.

- *The Examiner’s statement that “[f]urthermore, Pugh’s 103 rejection is purely to reject a printed matter set forth in the claim 16. The argument is thus moot” is legally incorrect*

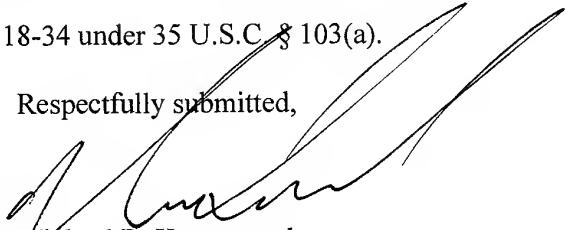
-The Examiner’s position is effectively to ignore the teachings of Pugh and the legal case law surrounding obviousness rejections. The simple fact remains that claim 16 is rejected as being obvious by Pugh. In order for Pugh to be properly used in an obviousness rejection, it must be analogous art irrespective of why the rejection is being made. *See* MPEP § 2141.01(a)(I). Pugh is non-analogous art. Therefore, the obviousness rejection should be withdrawn.

For at least these reasons, Appellant requests that the Board overturn the rejection of claim 16 under 35 U.S.C. § 103(a).

II. CONCLUSION

For at least the reasons stated above (and those in the Appeal Brief), Appellant requests that the Board overturn the rejection of claims 18-34 under 35 U.S.C. § 103(a).

Respectfully submitted,



Michael R. Krawzsenek
Reg. No. 51,898
Attorney for Appellant

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512)-536-3020

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